

REMARKS

This Amendment is being submitted concurrently with the accompanying Request for Continued Examination (RCE).

Claims 1-51 are now pending in this application. Claims 1, 15-18, 21, 24, 29-30, 33-36, and 44-49 are independent. Claims 1, 2, 4-14, 19, 21-23, 29, 33-34, 37, and 40-42 have been amended; claims 44-51 have been added; and no claims have been canceled by this Amendment.

No new matter is involved with any Specification and/or Claim amendment or new claim, as support may be found throughout the original Specification, including the originally-filed claims. In addition, various claims have been amended solely to correct the spelling of the word “signaling”.

Amendments to the Specification

The Specification has been amended for clarity by canceling a portion of one paragraph, as indicated above. Entry of the Amendment to the Specification is respectfully requested.

Anticipation Rejection Over Yoakum et al.

Withdrawal of the rejection of claims 1-4, 7-8, 13, 21, 22, 29, 323, and 34 under 35 U.S.C. §102(e) as allegedly being anticipated by Yoakum et al. (US 6735621) is requested.

Applicants note that anticipation requires the disclosure, in a prior art reference, of each and every limitation as set forth in the claims.¹ There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. §102.² To properly anticipate a claim, the reference must teach every element of the claim.³ “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”.⁴ “The identical invention

¹ *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

² *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991).

³ See MPEP § 2131.

⁴ *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

must be shown in as complete detail as is contained in the ...claim.”⁵ In determining anticipation, no claim limitation may be ignored.⁶ In view of the foregoing authority, the cited reference fails to anticipate independent claims 1, 21, 29, and 33-34, as amended.

Yoakum et al. fails to disclose a method that includes, *inter alia*, “**adding non-IP telephony signaling protocol service reference information** to an IP telephony signaling protocol message; and sending the IP telephony signaling protocol message to a network node”, as recited in independent claim 1, as amended (*emphasis* added).

Further, the applied art fails to disclose a communications system providing IP telephony that includes, *inter alia*, “...**a first network node...arranged to add non-IP telephony signaling protocol service reference information relating to a call made to the user equipment to an IP telephony signaling protocol message** and to send the IP telephony signaling protocol message to the second network node...” as recited in independent claim 21, as amended (*emphasis* added).

Still further, the applied art fails to disclose a communications system providing IP telephony that includes, *inter alia*, “...a first network node...wherein the first network node is arranged to add first service reference information relating to a call made to the user equipment to an IP telephony signaling protocol message initiating a session...**wherein the first service reference information is non-IP telephony signaling protocol service information**”, as recited in independent claim 29, as amended (*emphasis* added).

In addition, the applied art fails to disclose “[a] network node in a communications system providing IP telephony, wherein the network node comprises **means for adding non-IP telephony signaling protocol service reference information** to an IP telephony signaling protocol message”, as recited in independent claim 33, as amended (*emphasis* added).

Finally, the applied art fails to disclose “[a] network node in a communications system providing IP telephony, wherein the network node comprises **means for separating non-IP telephony signaling protocol service reference information** from an IP telephony signaling protocol message”, as recited in independent claim 34, as amended.

⁵ *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

⁶ *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 187 (Fed. Cir. 1990).

Accordingly, since the applied art fails to disclose all the claimed limitations, reconsideration and allowance of independent claims 1, 21, 29, 33, and 34 are respectfully requested.

Further, since dependent claims 2-14, 19-20, 22-23, and 37 variously and ultimately depend from now allowable independent claims 1, 21, and 33, these claims are submitted as being allowable at least on that basis, without further recourse to the additional patentable features recited therein.

Unpatentability Rejection over Yoakum et al.

Withdrawal of the rejection of claims 11, 12, 14, and 37 under 35 U.S.C. §103(a) as allegedly being unpatentable over previously cited Yoakum et al. is requested. The Examiner has failed to make a *prima facie* case of unpatentability because the applied art does not teach or suggest at least the claimed limitations of now amended independent claims 1 and 33 from which claims 11, 12, 14, and 37 variously and ultimately depend.

In addition, the Examiner improperly alleges that admitted deficiencies of the primary reference to Yoakum et al. are features are “well known to those of ordinary skill in the art”. Applicant respectfully traverses the Examiner’s assertion that various claimed limitations are “well known”, as discussed further below.

Legal Requirements for Unpatentability

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria offer useful insights. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference must teach or suggest all the claim limitations.***⁷ Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.⁸ The Supreme Court recently held that it is necessary, *inter alia*, for a court to look to interrelated teachings of multiple patents in order to determine

⁷ See MPEP §2143.

whether there was an apparent reason to combine the known elements in the claimed. In this regard, the Court held “[t]o facilitate review, this analysis should be made explicit.”⁹ “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”¹⁰

Specific Deficiencies of the Applied Art

The Examiner admits that Yoakum et al. does not specifically disclose that the telephony signaling protocol is OSA, Parlay API, or H.323 with respect to dependent claims 11, 12, and 14, but then asserts that “such signaling protocols are well known to those of ordinary skill in the art.” Further, the Examiner admits that Yoakum et al. does not specifically disclose that the network node comprises a call state control function with respect to dependent claim 37, but then asserts that “such functionality is well known in the art”.

Even if such an assertion is true, which Applicant does not admit as addressed further below, the applied art, taken alone or in combination, clearly does not teach or suggest a method that includes, *inter alia*, “**adding non-IP telephony signaling protocol service reference information** to an IP telephony signaling protocol message; and sending the IP telephony signaling protocol message to a network node”, as recited in independent claim 1, as amended (**emphasis added**), from which claims 11, 12, and 14 depend.

In addition, the applied art, taken alone or in combination, also clearly does not teach or suggest “[a] network node in a communications system providing IP telephony, wherein the network node comprises **means for adding non-IP telephony signaling protocol service reference information** to an IP telephony signaling protocol message”, as recited in independent claim 33, as amended (**emphasis added**), from which claim 37 depends.

Accordingly, since the applied art does not teach or suggest all the claimed limitations, reconsideration and allowance of claims 11, 12, 14, and 37 are respectfully requested.

⁸ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and *See* MPEP §2143.

⁹ *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ____ (2007) (*see* p. 14).

¹⁰ *See Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Improper Assertion of “Well Known” Features

Applicant traverses the Examiner’s assertion of “well known” features as outlined above. In terms of reliance upon common sense or common knowledge, in *Zurko*, the Federal Circuit reiterated to the Board of Appeals the following:

... the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is “basic knowledge” or “common sense” to one of ordinary skill in the art...the Board contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, “it is basic knowledge that communication in trusted environments is performed over trusted paths” and, moreover, verifying the trusted command in UNIX over a trusted path is “nothing more than good common sense.” *Ex parte Zurko*, slip op. at 8.

We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense.

Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. *Baltimore & Ohio R.R. Co. v. Aderdeen & Rockfish R.R. Co.*, 393 U.S. 87, 91-92 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record, noting that if the Court were to conclude otherwise “[the] requirement for administrative decisions based on substantial evidence and reasoned findings -- which alone make effective judicial review possible -- would become lost in the haze of so-called expertise”).

Accordingly, we cannot accept the Board’s unsupported assessment of the prior art.¹¹

More recently, the Federal Circuit pointed out in *Lee*¹² that the PTO must give full reasoning as to what motivation or teaching in the prior art would suggest combining [or modifying] references relied on in an obviousness rejection; and that *an Examiner’s general*

¹¹ *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

¹² *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir 2002).

common knowledge and common sense do not substitute for the authority required by law to reject a claim for obviousness.

In *Lee*, all claims in a patent application by Sang Su Lee (“Lee”) were denied. On appeal, the Board held that the Examiner’s conclusory statements constituted a well-reasoned discussion of why one should combine references relied on in the obviousness rejection. Because the only “reasoning” relied on was the Examiner’s “common knowledge and common sense,” the court concluded there was no showing to suggest that combining the references had been anything more than impermissible hindsight. Therefore, the court vacated and remanded.

Applicant submits that this case is directly on point. The Official Action does not establish the proper motivation to modify Yoakum et al. in the manner suggested, and relies solely upon the Examiner’s mere assertion that certain claimed limitations are “well known” or common knowledge, without establishing proper motivation to do so, and further does not provide a properly combinable reference that provides such a teaching, as required.

If, as the Examiner alleges, these dependent claim limitations are indeed “well known”, then it should present no burden to the Examiner to provide a ***properly combinable reference*** that teaches the missing limitations if a Notice of Allowability is not forthcoming in response to this Amendment.

Accordingly, withdrawal of the rejection and allowance of claims 11, 12, 14, and 37 are respectfully requested.

Allowable Subject Matter

Applicant notes with appreciation the indication that claims 5-6, 9-10, 15-20, 23-28, 30-32, 35, 36, and 38-43 are drawn to allowable subject matter, and would be allowed if rewritten in independent form.

Applicant submits that the indication of allowable subject matter should more clearly be structured to indicate that claims 15-18, 24-28, 30-32, 35-36, and 38-43 are ***allowed***, and that claims 5-6, 9-10, 19-20, and 23 are drawn to allowable subject matter and would be allowed if rewritten in independent form.

Allowance of claims 15-18, 24-28, 30-32, 35-36, and 38-43 is requested.

In addition, Applicant submits that otherwise allowable claims 5-6, 9-10, 19-20, and 23 are allowable at least for their dependence from presently amended independent claims 1 and 21, which are submitted as now being allowable. Allowance of claims 5-6, 9-10, 19-20, and 23 is also requested.

New Claims

New claims 44-51 have been drafted to avoid the applied art, and to further define that which Applicant is entitled to claim. Consideration and allowance of newly-presented claims 44-51 are respectfully requested. Support for these new claims may be found throughout the original Specification, including the originally-filed claims, so that no new matter is involved.

Conclusion

All rejections having been addressed, Applicant submits that each of pending claims 1-51 in the present application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the Undersigned Attorney is available at the telephone number indicated below.

For any fees that are due, including fees for excess claims and/or extensions of time, please charge Deposit Account Number 03-3975 from which the Undersigned Attorney is authorized to draw. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

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Respectfully submitted,

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